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EXAMINER

SUBRAMANIAN, NARAYANSWAMY

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL B. SUNDEL

Appeal 2008-004541
Application 09/996,825
Technology Center 3600

Decided: August 3, 2009

Before HUBERT C. LORIN, LINDA E. HORNER, and
ANTON W. FETTING, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL

An oral hearing was held on February 10, 2009.

STATEMENT OF THE CASE

Michael B. Sundel (Appellant) seeks our review under 35 U.S.C. § 134 (2002) of the final rejection of claims 1, 2, 4-11, 23-31, 33, 34, and 36-51. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We REVERSE but add a new ground of rejection under 35 U.S.C. § 112, second paragraph.¹

THE INVENTION

“The invention relates to an improved shipping method and system for facilitating shipments and management thereof, and more particularly to such a system and method for facilitating a shipment of a package of items from a Sender to a Recipient through one of a multitude of shipping mechanisms.” Specification [0001].

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

1. A computer-implemented method for processing shipment and return of a package containing items from a Sender to a Recipient, the method comprising the steps of:

electronically storing package data, for the package, and including item data, for the items in the package, in a database, before shipment occurs;

electronically retrieving shipment tracking data, for tracking shipment of the package from the Sender to the Recipient and return of one or more items of the items of the package from the Recipient to the Sender, from a shipping mechanism;

electronically adding the shipment tracking data to the database;

¹ Our decision will make reference to the Appellant’s Appeal Brief (“App. Br.,” filed Aug. 24, 2007) and Reply Brief (“Reply Br.,” filed Feb. 26, 2008), and the Examiner’s Answer (“Answer,” mailed Dec. 26, 2007).

electronically correlating the package data in the database with the shipment tracking data for the package;

electronically determining whether the package requires customs clearance and, if so, electronically generating the appropriate customs documentation or data transmission to a customs broker;

permitting an authorized user to query the database for processing the shipment of the package from the Sender to the Recipient and the return from the Recipient to the Sender of the one or more items of the items of the package; and

rendering data for display to the authorized user, based on a query of the database for shipping parameters of the package from the Sender to the Recipient and return from the Recipient to the Sender of the one or more items of the items of the package.

THE REJECTIONS

The Examiner relies upon the following as evidence of unpatentability:

Williams	US 2002/0032612 A1	Mar. 14, 2002
Le	US 2003/0069831 A1	Apr. 10, 2003

The following rejections are before us for review:

1. Claims 1, 2, 4-11, 23-31, 33, 34, and 36-51 are rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.
2. Claims 1, 2, 4-11, 23-31, 33, 34, and 36-51 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to

- particularly point out and distinctly claim the subject matter which applicant regards as the invention.
3. Claims 33, 34, and 36-51 are rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter because “[c]laims 33, 34[,] and 36-51 of the disclosed invention are inoperative and therefore lack utility.” Answer 4.
 4. Claims 1, 2, 4-11, 23-31, 33, 34, and 36-51 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Williams and Le.

ISSUES

1. Does the Specification fail to provide written descriptive support for the subject matter claimed in claims 1, 2, 4-11, 23-31, 33, 34, and 36-51 for the reasons stated by the Examiner?
2. Are claims 1, 2, 4-11, 23-31, 33, 34, and 36-51 indefinite for the reasons stated by the Examiner?
3. Are claims 33, 34, and 36-51 directed to non-statutory subject matter because they lack utility?
4. Does the combination of Williams and Le lead one of ordinary skill in the art to the subject matter claimed in claims 1, 2, 4-11, and 23-31; specifically, does Williams disclose the claim limitation “electronically storing package data, for the package, and including item data, for the items in the package, in a database, before shipment occurs” at [0148]-[0150], [0375], Figures 27A, and 40, as the Examiner has argued?

PRINCIPLES OF LAW

Utility

The test for utility is whether the application shows that the invention is useful to the public as disclosed. “Simply put, to satisfy the ‘substantial’ utility requirement, an asserted use must show that that claimed invention has a significant and presently available benefit to the public.” *In re Fisher*, 421 F.3d 1365, 1371 (Fed. Cir. 2005). “When a properly claimed invention meets at least one stated objective, utility under § 101 is clearly shown.” *Raytheon Co. v. Roper Corp.*, 724 F.2d 951, 958-59 (Fed. Cir. 1983). The test for operability is whether one of ordinary skill in the art would reasonably doubt the asserted utility.

As a matter of Patent Office practice, a specification which contains a disclosure of utility which corresponds in scope to the subject matter sought to be patented *must* be taken as sufficient to satisfy the utility requirement of § 101 for the entire claimed subject matter *unless* there is reason for one skilled in the art to question the objective truth of the statement of utility or its scope. Assuming that sufficient reason to question the statement of utility and its scope does exist, a rejection for lack of utility under § 101 will be proper on that basis; such a rejection can be overcome by suitable proofs indicating that the statement of utility and its scope as found in the specification are true.

In re Langer, 503 F.2d 1380, 1391-92 (CCPA 1974) (emphasis added).

Definiteness

The test for compliance is whether the claims set out and circumscribe a particular area with a reasonable degree of precision and particularity when

read in light of the application disclosure as they would be interpreted by one of ordinary skill in the art. *In re Moore*, 439 F.2d 1232, 1235 (CCPA 1971).

Written Description

“What is claimed by the patent application must be the same as what is disclosed in the specification; otherwise the patent should not issue.” *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 736 (2002). All that is necessary to satisfy the description requirement is to show that one is “in possession” of the invention. The decision in *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565 (Fed. Cir. 1997) accurately states the test.

One shows that one is ‘in possession’ of *the invention* by describing *the invention*, with all its claimed limitations, not that which makes it obvious. *Id.* (“[T]he applicant must also convey to those skilled in the art that, as of the filing date sought, he or she was in possession of *the invention*. The invention is, for purposes of the ‘written description’ inquiry, *whatever is now claimed*.”) (emphasis in original). One does that by such descriptive means as words, structures, figures, diagrams, formulas, etc., that fully set forth the claimed invention. Although the exact terms need not be used in *haec verba*, see *Eiselstein v. Frank*, 52 F.3d 1035, 1038 . . . (Fed. Cir. 1995) (“[T]he prior application need not describe the claimed subject matter in exactly the same terms as used in the claims . . .”), the specification must contain an equivalent description of the claimed subject matter.

Lockwood, 107 F.3d at 1572 (emphasis original). Compliance with the written description requirement is a question of fact. *Ralston Purina Co. v. Far-Mar-Co, Inc.*, 772 F.2d 1570, 1575 (Fed. Cir. 1985).

Obviousness

Section 103 forbids issuance of a patent when “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.”

KSR Int'l Co. v. Teleflex Inc., 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, and (3) the level of skill in the art. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 550 U.S. at 407 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”) The Court in *Graham* further noted that evidence of secondary considerations “might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” 383 U.S. at 17-18.

ANALYSIS

The rejection of claims 33, 34, and 36-51 under 35 U.S.C. § 101 as being directed to non-statutory subject matter because “[c]laims 33, 34[,] and 36-51 of the disclosed invention are inoperative and therefore lack utility.” Answer 4.

The Examiner’s reason for finding the claims lack utility is that the claims

[m]erely recite elements of an apparatus or a system (“means for” corresponds to software program elements and not [to] tangible hardware components) without showing any ability to realize functionality of the recited elements (i.e., functional descriptive material per se) and therefore is rendered inoperative lacking any utility. Figure 6 of the applicant’s drawings only shows some hardware elements of the system. It is not clear how these elements are related to the claimed invention. Applicant has not shown how these hardware elements map on to the limitations of the claimed invention.

Note that a computer (or software program) code cannot by itself perform the underlying function until it is loaded on some computer readable memory and accessed by the computer (or a processor). Functional descriptive material, per se, is not statutory. This is exemplified in *In re Warmerdam*[], 31 USPQ2d 1754 where the rejection of a claim to a disembodied data structure was affirmed. Thus a claim to a data structure, per se, or other functional descriptive material, including computer programs, per se, is not patent eligible subject matter.

Answer 4-5. The Examiner also states that

the examiner has broadly interpreted the claim as being drawn to elements of an apparatus or a system (“means for” corresponds to software

program elements and not tangible hardware components) without showing any ability to realize functionality of the recited elements (i.e., functional descriptive material per se) and therefore is rendered inoperative lacking any utility. The examiner has not applied the provisions of 35 [U.S.C. §]112, sixth paragraph in interpreting this claim because there is too much structure in the means plus function.

Answer 10.

The precise question before us is whether claims 33, 34, and 36-51 are directed to non-statutory subject matter because they lack utility. In that regard, we do not see that the Examiner has explained in what way the claimed subject matter fails to achieve a useful result. “To violate [35 U.S.C.] § 101 the claimed device must be totally incapable of achieving a useful result.” *Brooktree Corp. v. Advanced Micro Devices, Inc.*, 977 F.2d 1555, 1571 (Fed. Cir. 1992). The Specification explains that the method and system of the invention is for “facilitating shipments and management thereof” (Specification [0001]). Therefore the Appellant does appear to have provided disclosure of a useful result for the claimed subject matter. The record therefore appears to support the view that the claimed subject matter is drawn to a method and system for achieving the facilitation of shipments and management thereof. The Examiner does not explain in what way the claimed subject matter would be incapable of doing this. Accordingly, the Examiner has failed to establish a prima facie case that the subject matter of claims being rejected are directed to nonstatutory subject matter in violation of 35 U.S.C. § 101 on the ground that they lack utility.

While we do not see that the Examiner has explained in what way the claimed subject matter fails to achieve a useful result, we do see that the

Examiner has struggled to determine whether the claimed subject matter is directed to patent-eligible subject matter in compliance with 35 U.S.C. § 101. That struggle has led the Examiner to find claims 33, 34, and 36-51 to define only purely functional subject matter. If this finding were correct, we would agree that the claims define nonpatentable subject matter. *See, e.g., Expanded Metal Co. v. Bradford*, 214 U.S. 366, 383 (1909) (“It is undoubtedly true, and all the cases agree, that the mere function or effect of the operation of a machine cannot be the subject-matter of a lawful patent.”) But such a finding presumes the claims have been given the broadest reasonable construction in light of the Specification as they would be interpreted by one of ordinary skill in the art and that that construction leads to the conclusion that what is claimed in claims 33, 34, and 36-51 is nonstatutory subject matter. “[W]hether the ... patent is invalid for failure to claim statutory subject matter under § 101[] is a matter of both claim construction and statutory construction,” *State St. Bank & Trust Co. v. Signature Fin. Group*, 149 F.3d 1368, 1370 (Fed. Cir. 1998). We do not see here that the Examiner has made the appropriate claim construction analysis to support the finding the Examiner has made.

Claims 33, 34, and 36-51 are directed to “computer-implemented” systems and are in means-plus-function format. As such, there is a presumption that the Appellant intended to invoke treatment under 35 U.S.C. § 112, sixth paragraph. It was thus incumbent on the Examiner to first address that presumption and, if that presumption is not overcome, to construe the claims by giving them that treatment before reaching the question of statutory subject matter.

We note that the Examiner decided not to treat the claims under 35 U.S.C. § 112, sixth paragraph, because “there is too much structure in the means plus function” (Answer 10). While it is true that the presumption to invoke means-plus-function treatment under 35 U.S.C. § 112, sixth paragraph, may be rebutted when sufficient structure for performing the recited function is recited in the “means” limitation of the claims (*see Cole v. Kimberly-Clark Corp.*, 102 F.3d 524, 531 (Fed. Cir. 1996)), the Examiner does not explain what in the claims constitutes sufficient structure to rebut that presumption. Our reading of the claims reveals no recitation of any structure. What we read instead are means-plus-function limitations reciting nothing but the functions that each of the “means” must perform. Thus we disagree with the Examiner that the presumption that the Appellant intended to invoke means-plus-function treatment under 35 U.S.C. § 112, sixth paragraph, was rebutted.

However, we do agree that these claims raise a question of patentability. But that question is not at present one of statutory subject matter but rather a question of definiteness under the second paragraph of 35 U.S.C. § 112. The question is whether claims 33, 34, and 36-51 recite purely functional subject matter such that, structurally-speaking, the metes and bounds of the claims can not be determined by one of ordinary skill in the art. That question is addressed in the new ground of rejection, *infra*.

The rejection of claims 1, 2, 4-11, 23-31, 33, 34, and 36-51 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

The reason the Examiner gives for making this rejection is that “the specification does not provide a written description disclosure to support the

claimed limitation of ‘electronically storing package data, for the package, and including item data, for the items in the package, in a database, before shipment occurs.’” Answer 3 (emphasis original), referring e.g., to the first step in claim 1.

We disagree. Figure 3 and the accompanying discussion at [0028] describe actions conducted with respect to the package before the package is shipped. They included obtaining package data and putting that data in a database. We find this disclosure sufficient to show that the Specification contains an equivalent description for the claim limitation “electronically storing package data ... in a database, before shipment occurs.”

The rejection of claims 1, 2, 4-11, 23-31, 33, 34, and 36-51 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The reason given for this rejection is that “the limitation ‘tracking shipment of the package from the Sender to the Recipient and return of one or more items of the items of the package from the Recipient to the Sender’ [in claims 1 and 33] ... [has] no antecedent basis ... because the shipment or return of the package has not been positively recited before this limitation.” Answer 3-4. According to the Examiner, [t]here is no antecedent basis for this limitation because *the shipment or return of the package has not been positively recited* before this limitation. In fact it is not clear at what step of the method the shipment or return of the package occurs and hence it is not clear as to when the shipment tracking data is generated.” Answer 10 (emphasis added).

The Examiner is correct that a lack of antecedence in a claim may be a basis for raising a question of definiteness under the second paragraph of 35 U.S.C. § 112. “Lack of [an] antecedent basis in a claim *could* render it invalid under 35 U.S.C. § 112.” *In re Altenpohl*, 500 F.2d 1151, 1156 (CCPA 1974) (emphasis added). However, antecedent basis can be present by implication. *See Slimfold Mfg. Co. v. Kinkead Indus., Inc.*, 810 F.2d 1113, 1116 (Fed. Cir. 1987). Explicit antecedence is not required if the scope of a claim can be reasonably ascertainable. *Cf. Energizer Holdings, Inc. v. United States ITC*, 435 F.3d 1366, 1370-71 (Fed. Cir. 2006). “In *Bose Corp. v. JBL, Inc.*, 274 F.3d 1354, 1359 (Fed. Cir. 2001) the court held that despite the absence of explicit antecedent basis, ‘[i]f the scope of a claim would be reasonably ascertainable by those skilled in the art, then the claim is not indefinite.’”

Taking claim 1 as representative, the limitation “tracking shipment of the package from the Sender to the Recipient and return of one or more items of the items of the package from the Recipient to the Sender” follows the recitation in the preamble that the method is for “processing shipment and return of a package containing items from a Sender to a Recipient” and a step of storing package data, including item data, before shipment occurs. These recitations imply to one of ordinary skill in the art plainly reading the claim that the process claimed includes package and item shipment and return between Sender and Recipient as necessary preliminary steps to their tracking. If they are not shipped and returned, they cannot be tracked. Accordingly, in this situation, explicit antecedence “the shipment or return of the package” (Answer 10) is not required because it is implied by the claim as a whole.

As for the statement in the Answer “it is not clear at what step of the method the shipment or return of the package occurs and hence it is not clear as to when the shipment tracking data is generated” (Answer 10), we make this observation. By this statement, the Examiner appears to be arguing that the claim is indefinite because the claims do not further define the timing for tracking a package in relation to the package’s shipment and return. However, it appears to be clear from reading the claims that they describe tracking a package during package shipment and return. This may be broad. But breadth is not indefiniteness. *Cf. In re Robins*, 429 F.2d 452, 458 (CCPA 1970) (“Giving the language its broadest possible meaning, as we are bound to do in the absence of special definitions by appellant, the breadth of the claims insofar as the catalyst is concerned is indeed immense. However, ‘[b]readth is not indefiniteness.’ *In re Gardner*, 427 F.2d 786, 788 (1970).”).

The rejection of claims 1, 2, 4-11, 23-31, 33, 34, and 36-51 under 35 U.S.C. § 103(a) as being unpatentable over Williams and Le.

Claims 1, 2, 4-11, 23-31

We will reverse the rejection of the method claims 1, 2, 4-11, and 23-31 under § 103 as being unpatentable over Williams and Le.

There is no dispute that Le discloses the claim step of electronically determining whether the package requires customs clearance and, if so, electronically generating the appropriate customs documentation or data transmission to a customs broker. The dispute is over the scope and content of Williams; more specifically, whether Williams discloses all the other steps in the claims. For claim 1, the other steps (with the corresponding

disclosures in Williams that the Examiner (Answer 5-6) relied on as evidence that Williams discloses these steps) are:

- “electronically storing package data, for the package, and including item data, for the items in the package, in a database, before shipment occurs” ([0148]-[0150], [0375], Figures 27A, and 40);
- “electronically retrieving shipment tracking data, for tracking shipment of the package from the Sender to the Recipient and return of one or more items of the items of the package from the Recipient to the Sender, from a shipping mechanism” ([0148]-[0152], [0375]);
- “electronically adding the shipment tracking data to the database” ([0148]-[0152]);
- “electronically correlating the package data in the database with the shipment tracking data for the package” ([0149], [0455]-[0472]);
- “permitting an authorized user to query the database for processing the shipment of the package from the Sender to the Recipient and the return from the Recipient to the Sender of the one or more items of the items of the package” ([0028], [0030], [0133], [0136], [0152], and, [0375]-[0410]); and,

- “rendering data for display to the authorized user, based on a query of the database for shipping parameters of the package from the Sender to the Recipient and return from the Recipient to the Sender of the one or more items of the items of the package” ([0028], [0030], [0133], [0136], [0152], and, [0375]-[0410]).

The Appellant argues that Williams does not disclose all the features of the claims. App. Br. 9. According to the Appellant, “Williams appears to disclose a return tracking system where item data is stored upon the return of the item by the Recipient. Advantageously, the Appellant’s invention is distinct from Williams because individual items within a package are tracked before being shipped by the Sender. (See Specification ¶ 17).” App. Br. 10.

The Examiner disagreed, responding that

there is nothing in paragraph 17 of the Applicant's specification to suggest that individual items within a package are tracked before being shipped by the Sender. [Further] Williams discloses a computer-implemented method for processing shipment and return of a package containing items from a Sender to a Recipient (See the disclosure of Williams including the portions cited in the rejections). The limitations "sender" and "recipients" are given the broadest possible interpretation to include the "person who sends" and "the person who receives" regardless of whether the item is shipped for the first time or is being returned.

Answer 12.

Accordingly, the issue is whether Williams discloses the claim limitation "electronically storing package data, for the package, and including item data, for the items in the package, in a database, before shipment occurs" at [0148]-[0150], [0375], Figures 27A, and 40.

Each of [0148]-[0150] describes a database containing information, including package records. [0375], in a section entitled "1. Consumer Tracking," describes the ability of a consumer to track a return package once it has been shipped. Figure 27a depicts a shipping label for a package for an item to be returned (*see* [0071]). Figure 40 depicts an "exemplary Items Ordered Screen" ([0085]). (*See also* [0375]: "FIG. 40 depicts an Items Ordered Screen. By clicking on the Track your package link 405, the Consumer can track the package associated with the described item.")

We do not find in [0148]-[0150], [0375], Figures 27A, and 40, any disclosure of "electronically storing package data, for the package, and

including item data, for the items in the package, in a database, before shipment occurs.” This disclosure describes a database with package information and tracking return packages. But there is no disclosure of storing item data for the items in the package before shipment occurs.

Accordingly, the Examiner has failed to establish a prima facie case of obviousness. In light of this failure, the evidence of nonobviousness submitted to overcome a prima facie case of obviousness (i.e., the Declaration filed under 37 C.F.R. § 1.132 on Nov. 30, 2001) will not be considered.

Claims 33, 34, and 36-51

We vacate the rejection of claims 33, 34, and 36-51 under § 103 as being unpatentable over Williams and Le in light of the new ground of rejection under § 112, second paragraph, entered in this decision below. Given our finding below that the Specification does not describe the corresponding structure for the functions recited in the means-plus-function limitations of these claims so that the scope of the claims can be determined, we are not in a position to further determine whether the cited prior art discloses or would render obvious the claimed subject matter as whole. To do so would require us to use speculative assumptions about what the claims cover. *Cf. In re Steele*, 305 F.2d 859, 862-63 (CCPA 1962) (“As we have previously indicated, our analysis of the claims leaves us in a quandary as to what in fact is covered by them. We think the examiner and the board were

wrong in relying on what at best are speculative assumptions as to the meaning of the claims and basing a rejection under 35 U.S.C. § 103 thereon.”). *See also Ex parte Catlin*, (BPAI 2009) (precedential) (<http://www.uspto.gov/web/offices/dcom/bpai/prec/fd073072.pdf>), p. 12.

Our decision to vacate this rejection as to claims 33, 34, and 36-51 should not be interpreted that we have taken any position as to the merits of the rejection of these claims under § 103 as being unpatentable over Williams and Le. *See Steele*, 305 F.2d at 863 (“Our decision is not to be construed as meaning that we consider the claims on appeal to be patentable as presently drawn. These claims should, it seems to us, be reviewed to insure compliance with 35 U.S.C. § 112. *See In re Citron*, 251 F.2d 619, 45 C.C.P.A. 773.”).

NEW GROUND

Pursuant to 37 C.F.R. § 41.50(b) (2008), we enter a new ground of rejection of claims 33, 34, and 36-51 under 35 U.S.C. § 112, second paragraph as being indefinite.

We take claim 33², the sole independent claim, as representative of the claims being rejected. It is reproduced below.

33. A computer-implemented system for
processing shipment and return of a package

² Although we will focus on claim 33, we would raise the same question of patentability for each of claims 34, 36, 38, 39, 41, 42, 44, 49, 50, and 51 because, like 33, these claims are also in means-plus-function format and therefore the Specification must disclose sufficient structure corresponding to the functions recited in the means-plus-function limitations of these claims as well to avoid a finding of indefiniteness.

containing items from a Sender to a Recipient, the system comprising:

means for electronically storing package data, for the package, and including item data, for the items in the package, in a database, before shipment occurs;

means for electronically retrieving shipment tracking data, for tracking shipment of the package from the Sender to the Recipient and return of one or more items of the items of the package from the Recipient to the Sender;

means for electronically adding the shipment tracking data to the database;

means for electronically correlating the package data in the database with the shipment tracking data for the package;

means for electronically determining whether the package requires customs clearance and, if so, means for electronically generating the appropriate customs documentation or data transmission to a customs broker;

means for permitting an authorized user to query the database for processing the shipment of the package from the Sender to the Recipient and the return from the Recipient to the Sender of the one or more items of the items of the package; and

means for rendering data for display to the authorized user, based on a query of the database for shipping parameters of the package from the Sender to the Recipient and return from the Recipient to the Sender of the one or more items of the items of the package.

Claim 33 is written in means-plus-function format. A claim limitation that includes the term “means” is presumed to be intended to invoke means-plus-function treatment, i.e., treatment under 35 U.S.C. § 112, 6th paragraph.

Rodime PLC v. Seagate Tech., Inc., 174 F.3d 1294, 1302 (Fed. Cir. 1999). We do not have a situation here where (a) no function corresponding to the means or (b) sufficient structure for performing the recited function is recited in the “means” limitation of claim 21 to rebut the presumption that the Appellant intended to invoke means-plus-function treatment. *Cf., e.g., York Products, Inc. v. Cent. Tractor Farm & Family Ctr.*, 99 F.3d 1568, 1575-76 (Fed. Cir. 1996) and *Cole v. Kimberly-Clark Corp.*, 102 F.3d 524, 531 (Fed. Cir. 1996). When the presumption has not been rebutted, means-plus-function claim language must be construed in accordance with 35 U.S.C. § 112, paragraph 6, by “look[ing] to the specification and interpret[ing] that language in light of the corresponding structure, material, or acts described therein, and equivalents thereof, to the extent that the specification provides such disclosure.” *In re Donaldson Co.*, 16 F.3d 1189, 1193 (Fed. Cir. 1994) (en banc).

Construing means-plus-function claim language in accordance with 35 U.S.C. § 112, paragraph 6 is a two step process.

The first step in construing a means-plus-function claim limitation is to define the particular function of the claim limitation. *Budde v. Harley-Davidson, Inc.*, 250 F.3d 1369, 1376 (Fed. Cir. 2001). “The court must construe the function of a means-plus-function limitation to include the limitations contained in the claim language, and only those limitations.” *Cardiac Pacemakers, Inc. v. St. Jude Med., Inc.*, 296 F.3d 1106, 1113 (Fed. Cir. 2002)

The next step in construing a means-plus-function claim limitation is to look to the specification and identify the corresponding structure for that function. “Under this second

step, ‘structure disclosed in the specification is “corresponding” structure only if the specification or prosecution history clearly links or associates that structure to the function recited in the claim.’”
Med. Instrumentation & Diagnostics Corp. v. Elekta AB, 344 F.3d 1205, 1210 (Fed. Cir. 2003) (quoting *B. Braun Med. Inc. v. Abbott Labs.*, 124 F.3d 1419, 1424 (Fed. Cir. 1997)).

Golight, Inc. v. Wal-Mart Stores, Inc., 355 F.3d 1327, 1333-34 (Fed. Cir. 2004).

Step 1. The first step in construing a means-plus-function claim limitation is to define the particular function in the means-plus-function limitation.

Claim 33 recites multiple means-plus-function limitations. The particular functions of the means-plus-function claim limitations recited in claim 33 are

- “electronically storing package data, for the package, and including item data, for the items in the package, in a database, before shipment occurs;”
- “electronically retrieving shipment tracking data, for tracking shipment of the package from the Sender to the Recipient and return of one or more items of the items of the package from the Recipient to the Sender;”
- “electronically adding the shipment tracking data to the database;”
- “electronically correlating the package data in the database with the shipment tracking data for the package;”

- “electronically determining whether the package requires customs clearance and, if so, means for electronically generating the appropriate customs documentation or data transmission to a customs broker;”
- “permitting an authorized user to query the database for processing the shipment of the package from the Sender to the Recipient and the return from the Recipient to the Sender of the one or more items of the items of the package;” and,
- “rendering data for display to the authorized user, based on a query of the database for shipping parameters of the package from the Sender to the Recipient and return from the Recipient to the Sender of the one or more items of the items of the package.”

Further, given the computerized nature of these functions, one of ordinary skill in the art would construe the claim means-plus-function limitations as being *computer-enabled* means-plus-function limitations.

Step 2. The next step in construing a means-plus-function claim limitation is to look to the specification and identify the corresponding structure for that function. Given that the claim means-plus-function limitations are *computer-enabled* means-plus-function limitations, this step requires the Board to look to the Specification and identify the corresponding algorithms for the recited functions listed above.

For computer-implemented means-plus-function claims where the disclosed structure is a computer programmed to implement an algorithm, “the disclosed structure is not the general purpose computer, but rather the special purpose computer programmed to perform the disclosed algorithm.” *WMS Gaming, Inc. v. Int'l Game Tech.*, 184 F.3d

1339, 1349 (Fed. Cir. 1999). Thus the patent must disclose, at least to the satisfaction of one of ordinary skill in the art, enough of an algorithm to provide the necessary structure under § 112, ¶ 6. This court permits a patentee to express that algorithm in any understandable terms including as a mathematical formula, in prose, *see In re Freeman*, 573 F.2d 1237, 1245-46 (CCPA 1978), or as a flow chart, or in any other manner that provides sufficient structure.

The district court correctly determined that the structure recited in the '505 specification does not even meet the minimal disclosure necessary to make the claims definite. Simply reciting “software” without providing some detail about the means to accomplish the function is not enough. *See Aristocrat Techs. Austl. Pty v. Int'l Game Tech.*, 521 F.3d 1328, ---- (Fed. Cir. 2008) (“For a patentee to claim a means for performing a particular function and then to disclose only a general purpose computer as the structure designed to perform that function amounts to pure functional claiming. Because general purpose computers can be programmed to perform very different tasks in very different ways, simply disclosing a computer as the structure designated to perform a particular function does not limit the scope of the claim to ‘the corresponding structure, material, or acts’ that perform the function, as required by section 112 paragraph 6.”). This court does not impose a lofty standard in its indefiniteness cases. *See, e.g., Med. Instrumentation & Diagnostics Corp. v. Elekta AB*, 344 F.3d 1205, 1214 (Fed. Cir. 2003). But in this case, the claims are already quite vague. Without any corresponding structure, one of skill simply cannot perceive the bounds of the invention.

Finisar Corp. v. DirecTV Group, Inc., 523 F.3d 1323, 1340-41 (Fed. Cir. 2008).

When a Specification discloses *no* algorithm corresponding to a computer-enabled means-plus-function limitation in a claim, an applicant has necessarily failed to particularly point out and distinctly claim the invention as required by the second paragraph of section 112. *See Ex parte Catlin*, 90 USPQ2d 1603 (BPAI 2009) (precedential) (during prosecution, computer-enabled means-plus-function claims will be held unpatentable under 35 U.S.C. § 112, second paragraph, as being indefinite if a Specification fails to disclose any algorithm corresponding to the function in the claims). *See also Net MoneyIN*, 545 F.3d at 1367 (“[A] means-plus-function claim element for which the only disclosed structure is a general purpose computer is invalid if the specification fails to disclose an algorithm for performing the claimed function.”) The Federal Circuit has just recently decided another case involving indefiniteness of a computer-enabled means-plus-function limitation in a claim. *See Blackboard, Inc. v. Desire2Learn Inc.*, No. 2008-1368, slip op. at 21 (Fed. Cir. July 27, 2009) (finding Blackboard’s means-plus-function claims indefinite because the patent describes an undefined component, i.e., a black box, that performs the recited function but does not disclose how the component performs the function).

We have reviewed the record. We find that the Specification fails to disclose algorithms corresponding to the functions recited in claim 33.

An algorithm may be expressed in a variety of ways in a Specification to provide the necessary structure to comply with § 112, 6th paragraph. As the court in *Finisar* (*see supra*) has stated: “This court permits a patentee to

express that algorithm in any understandable terms including as a mathematical formula, in prose, *see In re Freeman*, 573 F.2d 1237, 1245-46 (CCPA 1978), or as a flow chart, or in any other manner that provides sufficient structure.”

But we do not find any disclosure expressing algorithms corresponding to the recited functions in claim 33.

The Appellant states that “[s]upport for the claimed features [of claim 33] can be found at least on e.g., Figure 6, paragraphs [0035], [0036], and [0039]-[0043] of the specification.” App. Br. 3.³ We reproduce those disclosures below.

³ This is the sum total of the discussion in the Briefs related to the support the Specification gives for the subject matter claimed in claim 33. We do not find this abbreviated discussion sufficient to explain the structure, material, or acts described in the Specification corresponding “to each claimed function” as required by 37 C.F.R. § 41.37(c)(1)(v) (2008).

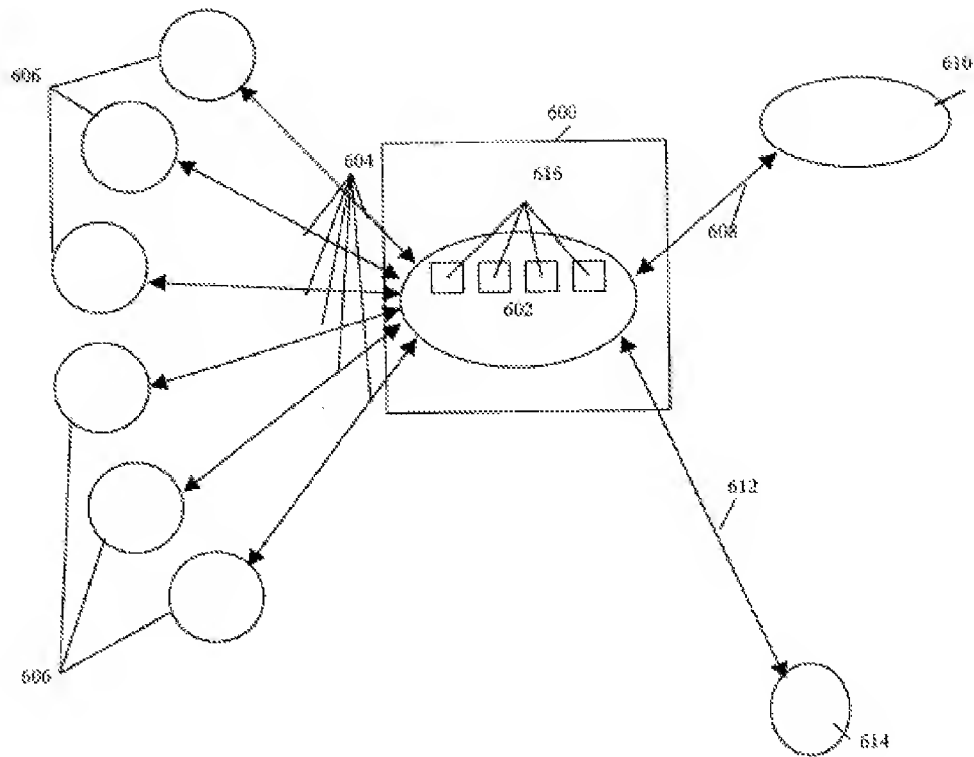


Figure 6

[0035] An apparatus for facilitating the shipment of a package is illustrated in Figure 6. The apparatus can be used to accomplish the procedures described above. The apparatus includes a processor 600 and a database 602 adapted in accordance with the preferred embodiment for storing and processing shipper, customs, and shipment data. As noted above, one type of database that can be used is organized by fields, records, and files, a field being a single piece of information; a record being a complete set of fields; and a file being a collection of records.

The database 602 contains records 616, each of which contains a number of fields, the fields containing the package data.

[0036] A first communications link 604 connects the processor/database 602 with the Sender's terminal 606, which is adapted for selectively sending data to and receiving data from the database 602. A second communications link 608 allows transfer of data between a shipper's terminal 610 and the processor/database 602. A third communications link 612 allows communication between the processor/database 602 and a customs broker's terminal 614, the customs broker being an entity that facilitates entry of shipments into another country.

[0039] Thus, the above-described shipment apparatus may be facilitated by use of the Internet. In such an arrangement, the communications link 604, the communications link 608, and the communications link 612 may all be accomplished over the Internet. The processor 600 may be on an Internet Web server.

[0040] The Sender's terminal 606 of the preferred embodiment includes a computer, for example, a personal computer, with access to the Internet. The Sender's computer can request a display of a Web page stored on the processor/database 602 by issuing a URL request through the communications link 604 to a processor in a known manner. A URL consistent with the present invention may be a simple URL of the form:

<protocol identifiers>://<server path>/<web page path>

A "protocol identifier" of "http" specifies the conventional hyper-text transfer protocol. A URL request for a secure Internet transaction typically utilizes the secure protocol identifier "https," assuming that the browser and Web server control application support and implement the secure sockets layer. The "server path" is typically of the form "prefix.domain," where the prefix is typically "www" to designate a Web server and the "domain" is the standard Internet sub-domain.top-level-domain of the processor/database 602. The optional "web page path" is provided specifically to identify a particular hyper-text page maintained on the processor/database 602. CGI scripts, Active Server Pages, or other technologies can be used to facilitate interactivity over the Internet.

[0041] The input device of the preferred embodiment typically includes a keyboard, a mouse, a bar code scanner, and a scale. However, the input device can include any number or combination of a keypad, keyboard, mouse, bar code reader, text scanner, image scanner, scale, or any other device for inputting data.

[0042] Similarly, the shipper's terminal 610 may comprise a computer similarly configured and connected to the Internet for displaying and inputting data through the second communications link 608 to the processor/database 602. Likewise, the customs broker's terminal 614 may also comprise a computer similarly configured and connected to the Internet for displaying and inputting data through the third communications link 612 to the processor/database 602.

[0043] In such an arrangement, the Internet acts as the first, second, and third communications

links 604, 608, and 612 between the processor/database 602 and the Sender's terminal 606, between the processor/database 602 and the shipper's terminal 610, and between the processor/database 602 and the customs broker's terminal 614.

These disclosures provide the elements of a general purpose computer that form the system for implementing the invention. However, the programming necessary for one of ordinary skill in the art to perform the functions recited in claim 33 is not provided. A plain reading of these disclosures by any person of skill in the art would reveal to such a person nothing about the structure corresponding to the recited functions. Nothing in these disclosures can be said to provide any insight into the structure, let alone the algorithmic structure, that corresponds to the functions recited in claim 33. Nothing in these disclosures provides one of ordinary skill in the art with any understanding of the programming necessary for a general purpose computer to implement the function recited in claim 33.

Accordingly, we find the Specification fails to disclose any algorithms to adequately describe sufficient corresponding structure for performing the functions recited in claim 33. Accordingly, we find that the Specification does not describe the corresponding structure so that the scope of the claim can be determined. For that reason, we further find claim 33, and claims 34 and 36-51 that depend on claim 33, in violation of 35 U.S.C. § 112, second paragraph, as being indefinite.

CONCLUSIONS OF LAW

We conclude that the Appellant has shown that the Examiner erred in rejecting claims 1, 2, 4-11, 23-31, 33, 34, and 36-51 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement; claims 1, 2, 4-11, 23-31, 33, 34, and 36-51 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention; and claims 33, 34, and 36-51 under 35 U.S.C. § 101 as being directed to non-statutory subject matter because of a lack of utility.

We also conclude that the Appellant has shown that the Examiner erred in rejecting claims 1, 2, 4-11, and 23-31 under 35 U.S.C. § 103(a) as being unpatentable over Williams and Le.

We enter a new ground of rejection of claims 33, 34, and 36-51 under 35 U.S.C. § 112, second paragraph, and therefore, under the *Steele* doctrine, vacate the rejection of claims 33, 34, and 36-51 under 35 U.S.C. § 103(a) as being unpatentable over Williams and Le.

DECISION

The decision of the Examiner to reject claims 1, 2, 4-11, 23-31, 33, 34, and 36-51 is reversed.

This decision contains new ground of rejection pursuant to 37 C.F.R. § 41.50(b) (effective September 13, 2004, 69 Fed. Reg. 49960 (August 12, 2004), 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)). 37 C.F.R. § 41.50(b) provides “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

- (1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner
- (2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

REVERSED; 37 C.F.R. § 41.50(b)

hh

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